

Application No. 10/772,102

REMARKS

Claims 1-14, 16-20, 23-28, 32-35 and 37-40 are pending. By this Amendment, claims 21, 22, and 29-31 are canceled without prejudice, and claims 16 and 18 are amended. New claims 38-40 are added, and Applicants note that a greater number of claims have been canceled than have been added as new claims. Claim 16 has been amended to add features of now canceled claim 30 and to remove features added during prosecution that the Examiner asserted corresponded to new matter. Claim 18 has been amended to add the features of now canceled claims 22 and 36 as well as to remove features added during prosecution that the Examiner asserted corresponded to new matter. New claims 38-41 correspond with claims 24-26 as filed. Also, the abstract has been amended to correct a typographical error. No new matter is introduced by the amendments.

Applicants note with appreciation that claims 1-14 and 33-37 have been allowed. New claims 38-41 depend from claim 33 and should be clearly allowable due to the allowability of claim 33. The Examiner further indicated that claim 30 would be allowable if written in independent form. Features of claim 30 have been introduced into claim 16, so that claim 16 should now be in allowable form. In view of the amendments of claim 18, Applicants believe that this claim and claims depending from this claim should also be allowable as explained in the following.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 16-18 under 35 U.S.C. § 112, first paragraph, as failing to satisfy the written description requirement. Specifically, the Examiner objected to the description in claim 16 of stirring during the contacting step of the claimed reaction and in claim 18 of the presence of crystal facets. While Applicants strenuously disagree with the Examiner's position on these issues, they are presently moot since Applicants have amended claims 16 and

Application No. 10/772,102

18 to remove the language objected to by the Examiner. In view of the amendments, the issues raised by the Examiner are moot, and Applicants respectfully request withdrawal of the rejection of claims 16-18 under 35 U.S.C. § 112, first paragraph, as failing to satisfy the written description requirement.

Rejection Over Riman et al.

The Examiner rejected claims 18, 20, 21, 25 and 32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,699,406 to Riman et al. (the Riman patent). To simplify the present discussion, Applicants incorporate by reference issues discussed in the Amendment of June 20, 2005. To advance prosecution of the application, Applicants have amended claim 18 to incorporate features of original claims 21 and 22. Since claim 22 was not rejected over the Riman patent, Applicants believe that this rejection is presently moot. In view of the amendment of claim 18, Applicants respectfully request withdrawal of the rejection of claims 18, 20, 21 and 25 under 35 U.S.C. § 103(a) as being unpatentable over the Riman patent.

Rejection Over WO 00/66485

The Examiner rejected claims 16, 27 and 29 under 35 U.S.C. § 103(a) as being unpatentable over WO 00/66485 to Tenne et al. (the Tenne application). To simplify the present discussion, Applicants incorporate by reference issues discussed in the Amendment of June 20, 2005. To advance prosecution of the application, Applicants have amended claim 16 to incorporate features of claim 30, which has now been canceled. Since claim 30 was not rejected over the Tenne application, Applicants believe that the present rejection is now moot. In view of the amendment of claim 16, Applicants respectfully request withdrawal of the rejection of claims 16, 27 and 29 under 35 U.S.C. § 103(a) as being unpatentable over the Tenne application.

Application No. 10/772,102

Rejection Over Colombet et al.

The Examiner rejected claims 16, 17, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,279,801 to Colombet et al. (the Colombet patent). To simplify the present discussion, Applicants incorporate by reference issues discussed in the Amendment of June 20, 2005. To advance prosecution of the application, Applicants have amended claim 16 to incorporate features of claim 30, which has now been canceled. Since claim 30 was not rejected over the Colombet patent, Applicants believe that the present rejection is now moot. Applicants respectfully request withdrawal of the rejection of claims 16, 17, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over the Colombet patent.

Rejection Over Sanjurjo et al.

The Examiner rejected claims 16, 18, 21, 24, 25, 27, 29, 31 and 32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,039,894 to Sanjurjo et al. (the Sanjurjo patent). To simplify the present discussion, Applicants incorporate by reference issues discussed in the Amendment of June 20, 2005. To advance prosecution of the application, Applicants have amended claims 16 and 18. With respect to claim 16, it was amended to add features from previous claim 30. Since claim 30 had been indicated as allowable, this should render moot the rejection of claim 16 and 27. Claims 29 and 31 have been canceled. With respect to claim 18, it has been amended to add features of previous claims 21 and 22, which have now been canceled. Since claim 22 was not rejected over the Sanjurjo patent, the present rejection of claims 18, 24, 25 and 32 should be moot. In view of the amendments, Applicants respectfully request withdrawal of the rejection of claims 16, 18, 21, 24, 25, 27, 29, 31 and 32 under 35 U.S.C. § 103(a) as being unpatentable over the Sanjurjo patent.

Application No. 10/772,102

Rejection Over Hampden-Smith et al.

The Examiner rejected claims 16, 18-22, 24-27, 29, 31 and 32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,645,398 to Hampden-Smith et al. (the Hampden-Smith patent). To simplify the present discussion, Applicants incorporate by reference issues discussed in the Amendment of June 20, 2005. To advance prosecution of the application, Applicants have amended claims 16 and 18. With respect to claim 16, it was amended to add features from previous claim 30. Since claim 30 had been indicated as allowable, this should render moot the rejection of claims 16 and 27. Claims 29 and 31 have been canceled. With respect to claim 18, it has been amended to add features of previous claims 21 and 22, which have now been canceled. With respect to claims 18-20, 24-26 and 32, Applicants respectfully assert that the Hampden-Smith patent does not teach or suggest particles with essentially no particles having a diameter greater than about 5 times the average diameter, as is presently claimed. Applicants respectfully request reconsideration of the rejection based on the following comments.

The Hampden-Smith patent describes average particle sizes at column 37, line 64 to column 38, line 6 and the distribution of particle sizes at column 38, lines 7-25. Since the Hampden-Smith particles are fused primary particles/crystallites, the particle collections as described in the Hampden-Smith patent would not be expected to inherently have the sharp cut off in particle size presently claim in claim 18. Since the Hampden-Smith patent does not teach or suggest all of the features of Applicants' claimed composition, the Hampden-Smith patent does not render Applicants' claimed invention *prima facie* obvious. Applicants respectfully request withdrawal of the rejection of claims 16, 18-22, 24-27, 29, 31 and 32 under 35 U.S.C. § 103(a) as being unpatentable over the Hampden-Smith patent.

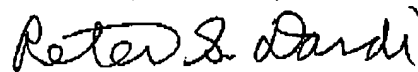
Application No. 10/772,102

CONCLUSIONS

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Peter S. Dardi, Ph.D.  
Registration No. 39,650

Customer No. 24113  
Patterson, Thuent, Skaar & Christensen, P.A.  
4800 IDS Center  
80 South 8th Street  
Minneapolis, Minnesota 55402-2100  
Telephone: (404) 949-5730